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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
200316482-1

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on 7/6/2006

Signature Sarah L. Reinhard

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Application Number
10/809,151

Filed
3/25/04

First Named Inventor
Antony M. Justin

Art Unit
2876

Examiner
Kumiko C. Koyama

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☐ attorney or agent of record.
Registration number _____
- ☒ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 40,925

Signature Edward J. Brooks III

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7/6/2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Application No. : 10/809,151 Confirmation No.: 7395
Applicant: : Antony M. Justin
Filed: : March 25, 2004
TC/A.U. : 2876
Examiner: : Kumiko C. Koyama

Docket: : 200316482-1
Customer No.: : 022879

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Commissioner for Patents
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Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

The claims in the above-referenced patent application have been twice rejected. Applicant believes all of the claim rejections to be clearly erroneous, and requests a pre-appeal brief review as described in the Official Gazette, 12 July 2005.

The present invention relates to an information card and a method for use of the information card.

Rejection under 35 USC § 103(a)

The examiner has rejected all of the independent claims 1, 4, 13, 19, and 22 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,884,271 to Pitroda (hereinafter "Pitroda") in view of U.S. Patent No. 4,868,376 to Lessin et al. (hereinafter "Lessin").

In the Office Action dated November 16, 2005, the Examiner rejected all of Applicant's independent claims under 35 U.S.C. § 102(b) as being anticipated by Pitroda. Applicant amended independent claims 1, 4, 13, 19, and 22 in a Response and Amendment filed February 13, 2006 overcoming the Pitroda 102 rejection. For example, Applicant amended the claims such that the information card includes, among other things, "program instructions storable in the memory and executable by the processor to selectably modify the variety of user information, including updating, editing, and deleting, based on user input directly to the card".

As defined in the Applicant's specification as originally filed, "the variety of user information" includes such items as "a social security number, a driver license record, and a bank account record. . .". (See, page 2, lines 12-15).

Presently, the Examiner has rejected Applicant's claims under 35 U.S.C. § 103(a) based on Pitroda in view of Lessin. To note, the Examiner admits that Pitroda fails to teach all of the limitations of Applicant's claims (Final Office Action, page 3). For example, the Examiner admits that Pitroda does not disclose "program instructions storable in the memory and executable by the processor to selectably modify the variety of user information, including updating, editing and deleting, based on user input directly to the card." (Final Office Action, page 3).

The Examiner has relied on Lessin to cure the deficiencies of Pitroda in stating:

Lessin also teaches that if the cardholder selects the change PIN function, the cardholder is prompted to enter the current PIN by the display depicted in box (col 13, lines 20-22). The cardholder is prompted for the new PIN he wishes to enter by displays. After the new PIN is entered, the new PIN entered, the cardholder is prompted to reenter the new PIN by displays (col 13, lines 29-32). The cardholder re-enters the new PIN correctly, the current PIN is replaced with the new PIN and the cardholder is informed of this by the display at box (col 13, lines 45-48). (Final Office Action, pages 3-4).

The Examiner then concluded that "it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to integrate the teachings of Lessin to the teachings of Pitroda in order to customize the card according to the user such that the card is user specific and therefore, the card always contains the most recent information as well as providing enhanced security by personalizing the card." (Final Office Action, page 4).

Applicant respectfully submits that changing a PIN as described in Lessin is not equivalent to "**modifying the variety of user information**, including updating, editing, and deleting, based on user input directly to the card" as recited in each of the Applicant's independent claims. As mentioned above, the Applicant's specification has defined the "variety of user information" to include such items as "a social security number, a driver license record, and a bank account record". (Page 2, lines 12-15).

Although Lessin appears to teach that the cardholder can directly change the PIN, the PIN is used only for security measures (col. 4, lines 27-29) which does not equate to the user

information as defined by the Applicant. Additionally, the Examiner has acknowledged that all other user information, excepting the PIN, is only modifiable by the card issuer in stating:

the application routine program can be changed, removed or deleted according to the ITC cardholder's needs by the issuer of the card (col 10, lines 25-30). Lessin teaches that the application programs may only be input by authorized manufacturers o[r] issuers of the ITC (col 3, lines 66-68).” (Final Office Action, page 3) (emphasis added).

From this, Lessin appears to teach that the PIN secures access to the card by having the cardholder enter the PIN to identify that the person entering the PIN is in fact the intended cardholder. However, Lessin does not appear to teach that the cardholder can **modify the variety of user information**, including updating, editing, and deleting, based on user input directly to the card, as provided in independent claims 1, 4, 13, 19, and 22. This aspect of the Applicant’s claims provides particular utility to embodiments of the invention since the user information can include such a variety of user information, e.g., a social security number, bank account information, and/or driver’s license record, as discussed above. Moreover, Applicant respectfully submits that the Pitroda and Lessin references are not combinable in that Lessin teaches away from the Applicant’s claimed invention and that combining the references would destroy the stated purpose of Lessin. (MPEP 2143.01). For example, Lessin states:

The application programs may **only** be input by authorized manufacturers or issuers of the ITC. This secures the ITC against unauthorized access and **programming or reprogramming**. The application programs are preferably input by the issuer of the card through the input/output ports. For example, if the ITC is used for payment of public transportation, the transportation authority would load the application into the ITC and issue the card to the cardholder. (Col. 3, line 67-Col.4, line 7).

Therefore, Applicant respectfully submits that although Lessin appears to describe that a cardholder can change a PIN directly, Lessin actually teaches away from allowing the user to modify the variety of user information directly and that allowing the user to do so would defeat the intent of Lessin. Hence, the references do not describe, teach, or suggest, either independently or in combination, that a cardholder can “modify the variety of user information” as recited in each of the Applicant’s independent claims and as defined in the Applicant’s specification as filed.

As such, Applicant respectfully requests reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) for independent claims 1, 4, 13, 19, and 22, as well as those claims which depend therefrom.

In addition, the Examiner rejected claims 3, 8, and 18 as being unpatentable over Pitroda in view of Lessin as applied to claims 1, 4, and 13 above, and further in view of U.S. Patent No. 6,325,285 to Baratelli. Claims 3, 8, and 18 depend from independent claims 1, 4, and 13, respectively. For the reasons presented above, Applicant believes these independent claims are allowable over Pitroda and Lessin. The Examiner relies on Baratelli to teach "a biometric identification mechanism." However, Baratelli does not appear to cure the deficiencies of Pitroda in view of Lessin, as discussed above, with respect to the ability to "modify the variety of user information, including updating, editing, and deleting, based on user input directly to the card", as provided in independent claims 1, 4, and 13. Applicant therefore believes that the rejection under 35 U.S.C. §103(a) to be improper, and respectfully requests that it be reversed.

Further, the Examiner rejected claim 14 as being unpatentable over Pitroda in view of Lessin as applied to claim 13 above, and further in view of U.S. Patent No. 6,293,462 to Gangi and U.S. Patent No. 5,055,662 to Hasegawa. Claim 14 depends from independent claim 13. For the reasons presented above, Applicant believes that independent claim 13 is allowable over Pitroda and Lessin. The Examiner relies on Gangi and Hasegawa to teach "a card having an optical sensor and a magnetic strip." However, Gangi and Hasegawa do not appear to cure the deficiencies of Pitroda in view of Lessin, as discussed above, with respect to the ability to "modify the variety of user information, including updating, editing, and deleting, based on user input directly to the card", as provided in independent claim 13. Applicant therefore believes that the rejection under 35 U.S.C. §103(a) to be improper, and respectfully requests that it be reversed.

Claim Objections

Regarding the claim objections for claims 1, 4, and 13, Applicant will happily modify the objected to claims according to the Examiner's helpful suggestions upon favorable disposition of the present pre-appeal.

Conclusion

This pre-appeal request for review is being submitted with a Notice of Appeal and the appropriate fee.

The Examiner is invited to telephone the Applicant's attorney David W. Boyd at (970) 898-4475 to facilitate disposition of this matter. At any time during the pendency of this application, please charge any additional fees or credit overpayment to the Deposit Account No. 08-2025.


CERTIFICATE UNDER 37 CFR §1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS AF Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on this 6th day of July, 2006.

Sarah L. Reinhard
Name

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Respectfully Submitted,
Antony M. Justin

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By: 
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Reg. No. 40,925

Date: 7/6/2006